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09/720,770	08/30/2001	Anthony Jacques Louis De Breed	702-001869	5871

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Richard L Byrne  
700 Koppers Building  
436 Seventh Avenue  
Pittsburgh, PA 15219-1818

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/18/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/720,770

Applicant(s)

DE BREED, ANTHONY JACQUES LOUIS

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:



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This is in response to application and preliminary amendment filed on August 30, 2001 in which claims 30-55 are presented for examination.

**Status of the Claims**

Claims 30-55 are pending.

***Information Disclosure Statement***

The information disclosure statement filed May 21, 2002 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 U.S.C. 101 because the claim recites a single mean.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth



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rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30 and 48 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites the limitation "the addresses" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 35 recites the limitation "the presence" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the sender" in line 2. There is insufficient antecedent basis for this limitation in the claim.



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Claim 38 recites the limitation "the results"; "the filtering steps" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "the sender" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitation "the addressee" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 43 recites "they can" in line 2, pronouns are not allowed. Only what is being referred by they should be set forth in the claim.

Claim 44 recites "him" in line 3, pronouns are not allowed. Only what is being referred by him should be set forth in the claim.

Claim 46-47 recite "who" in line 2, pronouns are not allowed. Only what is being referred by who should be set forth in the claim.

Claim 48 recites the limitation "the web page" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 49 recites the limitation "the messages" ; "the recipient"; "the sender"; "the e-mail address" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 50 recites the limitation "the address" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 54 recites the limitation "the message traffic" in line 2. There is insufficient antecedent basis for this limitation in the claim.



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 30-33, 30-40 and 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Benjamin et al. WO 99 40527 A.

As per claim 30, WO 99 40527 A (RODDA NICHOLAS ALAN ;A PTY LTD (AU); BENJAMIN DENNIS ANDREW (AU)) 12 August 1999 (1999-08-12) discloses a method for addressing e-mails to a person or organization via electronic means (page 3, lines 20-24), wherein the addresses of people and/or organizations are stored in ,a database (page 3, lines 25-26), wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal



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codes such as name, telephone numbers, fax number and/or postal codes (page 4, line 22-page 5, line 14; page 7, line 12-30; page 9, lines 20-24).

As per claim 31, most of the limitations of this claim have been noted in the rejection of claim 30. Applicant's attention is directed to the rejection of claim 30 above. In addition, Benjamin et al. disclose the claimed features of sending one or more e-mail messages to one or more recipients by disclosing combinations of one or more identifying elements associated with the intended recipient as well as mechanism for transmitting messages (page 3, lines 26-27; page 5, lines 2-14).

As per claims 32-33 most of the limitations of these claims have been noted in the rejection of claim 31. Applicant's attention is directed to the rejection of claim 31 above. In addition, Benjamin et al. disclose the claimed features of "one or more steps for inputting message data comprising at least one or more items of the publicly accessible data"; by providing steps for receiving an email message including publicly accessible data (See Benjamin et al. Page 4, lines 1-2, 8-9, 15 and 22-24). As to advance notice data, subject data, content data, parameter data and area of interest data, Benjamin et al. provides mechanism for sending notification message to the sender of an email message (See Benjamin et al. Page 4, lines 7-13).

As per claim 39, most of the limitations of this claim have been noted in the rejection of claim 31. In addition, Benjamin et al. disclose sending status messages to



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the message to the sender by sending a notification message to the sender of the email message (see Benjamin Page 4, lines 7-13; page 5, lines 15-26).

As per claim 40, most of the limitations of this claim have been noted in the rejection of claim 31. In addition, Benjamin et al. disclose assisting in a manual search for addresses in the database (Page 4, lines 1-6).

As per claims 46-47, most of the limitations of these claims have been noted in the rejection of claim 30. In addition, Benjamin et al. disclose Notifying recipients that are not yet registered by the system (See Benjamin et al. page 5, last paragraph).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-38, 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin et al. WO 99 40527 A in view of Kasiraj et al. European Patent Application 0 375 138 A2.



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As per claims 34-38, most of the limitations of these claims have been noted in the rejection of claim 31. Applicant's attention is directed to the rejection of claim 31 above.

It is noted, however, Benjamin et al. did not specifically detail the aspects of filtering e-mail messages, such as e.g. for viruses, spam or transmission permission as recited in the instant claims 34-38. On the other hand, Kasiraj et al. achieved the aforementioned limitations by providing mechanism for restricting delivery and receipt of electronic messages (see Kasiraj et al. Figs. 2, 3; Col. 2, lines 6-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the systems of Benjamin et al. and Kasiraj et al. because they are both directed to electronic message deliveries and are both from the same field of endeavor. The skilled person would therefore regard it as a normal option to include the restriction features in the method described by Benjamin et al. in order to solve the problem posed.

As per claims 54-55, most of the limitations of these claims have been noted in the rejection of claim 31. Applicant's attention is directed to the rejection of claim 31 above. In addition, Kasiraj et al. disclose mechanism for securing message traffic (See Kasiraj Col. 2, lines 6-35; Col. 6, lines 34-42).

Claims 34-38, 41-45, 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin et al. WO 99 40527 A in view of Paul WO 9933188A2



As per claims 34-38, most of the limitations of these claims have been noted in the rejection of claim 31. Applicant's attention is directed to the rejection of claim 31 above.

It is noted, however, Benjamin et al. did not specifically detail the aspects of filtering e-mail messages, such as e.g. for viruses, spam or transmission permission as recited in the instant claims 34-38. On the other hand, Paul achieved the aforementioned limitations by providing a filtering mechanism for controlling delivery of unsolicited email messages (see Paul Figs. 2,3,5; page 2, line 5-page 4, line 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the systems of Benjamin et al. and Paul because they are both directed to electronic message deliveries and are both from the same field of endeavor. The skilled person would therefore regard it as a normal option to include the filtering mechanism features in the method described by Benjamin et al. in order to solve the problem posed.

As per claims 41-42, most of the limitations of these claims have been noted in the rejection of claim 37. Applicant's attention is directed to the rejection of claim 37 above. In addition, Benjamin et al. disclose retrieving an address on the basis of the addressing data, said addressing data being of different types, like name, telephone number, etc. (see page 11, paragraph 2; page 4, line 25-page 5, line 14). Furthermore,



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the retrieving step can be performed automatically or manually (see page 6, lines 715; page 7, paragraph 2).

As for claims 43-45, most of the limitations of these claims have been noted in the rejection of claim 30 above. In addition, Paul disclose the features of claims 43-45 and recognizes that it is customary practice to register users by means of user profiles comprising among others also exclusion/permission lists etc. ; see (Paul Figs. 2,3,4).

As per claim 48, Benjamin et al. also disclose electronic address of a person or organization (See rejection of claim 30).

As per claims 49-53, Benjamin et al. also disclose messages addressed with email address of a recipient; name and telephone number as part of the address; database forms part of the internet site; searching for messages; deleting messages (See Benjamin et al. Figure 3 and corresponding text ).

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

  
Frantz Coby  
Primary Examiner  
Art Unit 2171

December 11, 2003